

Appl. No. : 09/636,278
Filed : August 10, 2000

REMARKS

In response to the Office Action mailed May 18, 2004, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments. Applicant has amended independent claim 43 to further distinguish over the cited references. Applicant has amended claims 48, 49 and 51-54 to depend on independent claim 43, rather than dependent claim 44. Applicant has amended the preamble of independent claim 55 and asserts that independent claim 55 is neither anticipated nor rendered obvious by the cited references. Accordingly, Applicant believes the pending claims are now fully in condition for allowance.

Please note that the present amendments to claims 43 and 55 were previously presented in Applicant's "Amendment After Final," filed on July 19, 2004. However, in the Advisory Action dated October 29, 2004, the Examiner asserted that the proposed amendments raise new issues that would require further consideration and/or search and therefore the Examiner did not enter the amendments. Accordingly, Applicant has presented the amendments to claims 43 and 55 again along with new amendments to claims 48, 49 and 51-54 and a timely filed Request for Continued Examination in compliance with 37 C.F.R. § 1.114. No new matter has been added by this amendment.

Rejection of Claims 43, 44, 48, 49, 53-55 and 58-64 under 35 U.S.C. §102(e)

The Examiner rejects claims 43, 44, 48, 49, 53-55 and 58-64 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,001,118 to Daniel et al.

In response to the Examiner's rejections, Applicant has amended independent claim 43 to recite "an expandable member at the distal end portion of the tubular member, the expandable member being formed at least in part from a braided structure." Claim 43 also now recites "an occluding membrane encapsulating the expandable member, the occluding membrane being configured to completely occlude blood flow in the vascular segment." Daniel et al. neither teaches nor suggests an expandable member formed at least in part from a braided structure, wherein the expandable member is encapsulated by an occluding membrane configured to completely occlude blood flow. Rather, Daniel et al. merely discloses an expandable filter for capturing emboli in a body lumen.

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With respect to claim 55, Applicant notes that the current language recites "a covering disposed over the expandable member configured to expand with the expandable member and further configured to *interrupt fluid flow* through a vascular segment when the expandable member is in the expanded configuration." As discussed above, Daniel et al. merely discloses an expandable filter and neither teaches nor suggests anything about a covering for interrupting fluid flow through a vascular segment.

For at least the above reasons, Applicant's independent claims 43 and 55 recite features which are neither disclosed nor suggested by the Daniel et al. Dependent claims 44, 48, 49, 53, 54 and 58-64 recite additional features that further distinguish the claimed invention over the Daniel et al. Accordingly, Applicant respectfully requests that the rejection of claims 43, 44, 48, 49, 53-55 and 58-64 under 35 U.S.C. §102(e) be withdrawn.

Rejection of Claim 56 under 35 U.S.C. §103(a)

The Examiner rejects claim 56 under 35 U.S.C. §103(a) as being unpatentable over Daniel et al. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Daniel et al. fails to teach or suggest anything about a covering for interrupting fluid flow through a vascular segment, as recited by Applicant in independent claim 55. Claim 56 depends on claim 55. Accordingly, Applicant respectfully requests that the rejection of claim 56 under 35 U.S.C. §103(a) be withdrawn.

Allowable Subject Matter

Applicant appreciates the Examiner's determination that claims 45-47 would be allowable if rewritten in independent form.

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CONCLUSION

In view of Applicant's amendments and remarks, Applicant earnestly believes that each of the pending claims is now in condition for allowance. Should the Examiner have any remaining concerns, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: November 17, 2004

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